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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,376	07/03/2003	Kazunori Mukasa	01096C/LH	7198

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NEW YORK, NY 10017-2023

EXAMINER

KIM, ELLEN E

ART UNIT	PAPER NUMBER
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2874

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,376

Applicant(s)

MUKASA, KAZUNORI

Examiner

Ellen Kim

Art Unit

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/798,440.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The α curve is not clearly described in the original specification of this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2, 5-9, and 18 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Aikawa et al [Applicant's submitted prior art, "Yokyo Core Danmenseki wo Kakudai shita Single Mode Hikari Fiber", Proceedings 1 of Electronics Society Meeting in 1999, the institute of Electronics, Information and Communication Engineers, page 183, C-3-77].

Aikawa et al disclose an optical fiber having a dispersion value of 21.9 ps/nm/km and A value of $133 \mu\text{m}^2$, wherein $A > 3 \times D + 40$ [see 3rd paragraph of the left column in page 183].

In re claim 2, Aikawa et al show at the last column of the left column of the page 183 that the bending loss at a bending diameter of 20 mm is 1.0 dB/m.

In re claim 5, Aikawa et al show at the last column of the left column of the page 183 that the dispersion slope is $0.068 \text{ ps/nm}^2/\text{km}$.

In re claim 6, Aikawa et al do not specifically show that the polarization mode dispersion value is $0.15 \text{ ps/km}^{1/2}$, however, since Aikawa et al show all the other claimed structural limitation, it is clear that the polarization mode dispersion value of $0.15 \text{ ps/km}^{1/2}$ is inherently shown in the Aikawa et al's device.

Claims 1, 4, 8, 9, and 18 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kato et al [Applicant's submitted prior art, EP 0 862 069 A2].

Kato et al disclose an optical fiber having a dispersion value of 12 ps/nm/km, and A value of $120 \mu\text{m}^2$, wherein $A > 3 \times D + 40$ [see fig. 2 and 8A].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aikawa et al [Applicant's submitted prior art, "Yokyo Core Danmenseki wo Kakudai shita Single

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Mode Hikari Fiber", Proceedings 1 of Electronics Society Meeting in 1999, the institute of Electronics, Information and Communication Engineers, page 183, C-3-77].

Aikawa et al discloses every aspect of claimed invention except for the dispersion value of 14 to 17 ps/nm/km. It would have been obvious to the ordinary skilled person in the art at the time the invention was made to modify the Aikawa et al's device to include the dispersion value close to 17 ps/nm/km for the purpose of higher coupling efficiency of the device.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 10-17 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-8 of prior U.S. Patent No. 6,600,862. This is a double patenting rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen Kim whose telephone number is (703) 308-4946. The examiner can normally be reached on Monday and Friday.

Ellen E. Kim
Primary Examiner
April 13, 2004/EK

A handwritten signature in black ink, appearing to be 'EEK', is written over the printed name 'Ellen E. Kim'.